GP/1714

"PATENT"

AMENDMENT TRANSMITTAL FORM

In re application of: Alan G. Blahey et al
U. S. Serial No.: 09/806,873
Filed: April 3, 2001
For: Long Life Gas Engine Oil and Additive System

) Before the Examiner
) Cephia D. Toomer
)
) Group Art Unit 1714

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

[X] The undersigned hereby certifies having information and a reasonable basis for belief that this correspondence will be deposited as first-class mail with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on OCTOBER 4, 2001.

Transmittal herewith is an amendment/response in the above-identified application.

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Petition for extension of time pursuant to 37 CFR 1.136 and 1.137 is hereby made, if and to the extent required. The fee for this extension of time is calculated to be $_____ to extend the time for filing this response until _____.

The fee for any changes in number of claims has been calculated as shown below.

CLAIMS AS AMENDED						
(1)	(2) Claims Remaining After Amendment	(3)	(4) Highest Number Previously Paid For	(5) Present Extra	(6) Rate	(7)
Total Claims	*	Minus	**		x 18.00	
Indep. Claims	*	Minus	***		x 84.00	
MULTIPLE DEPENDENT CLAIM FEE					$280.00	
					FEE FOR CLAIM CHANGES	

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.
** If the "Higher Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The total fee for this Amendment, including claim changes and any extension of time is calculated to be $ 0.

[X] Charge $ 0 to Deposit Account No. 05-1330.

[X] The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 and 1.17 which may be required by this paper, or credit any overpayment, to Deposit Account No. 05-1330. A duplicate copy of this Form is enclosed.

Oct 3, 2001
Date of Signature

Joseph J Allocca
Attorney or Agent of Record

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[X] Pursuant to 37 CFR 1.34(a)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alan G. Blahey et al)
) Before the Examiner
U. S. Serial No. 09/806,873) Cephia D. Toomer
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Filed: April 3, 2001)
) Group Art Unit 1714
Long Life Gas Engine Oil and Additive System)

Commissioner for Patents
Washington, DC 20231

Sir:

AMENDMENT

In response to the Office Letter of July 27, 2001 please amend the claims as set forth in the attachment captioned "Amended Claims with Markings".

DETAILED AMENDMENTS

Applicants have amended claim 1 to specify that the lube oil has a viscosity between 9 and 20 cSt at 100°C.

Claim 2 was amended to delete reference to the lube oil viscosity which now is recited in claim 1.

I hereby certify that I have a reasonable basis for believing that this correspondence will be deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on OCTOBER 4, 2001.
Date of Deposit

KATHLEEN A. KUNA — Kathleen A. Kuna — October 4, 2001
Name of attorney or agent — Signature — Date of Signature

Claim 3 was cancelled.

Claim 4 was amended to depend from claim 2.

Claim 6 was amended to specify that the antioxidant and VI improvers are added to a base oil having a viscosity of from 9 to 20 cSt at 100°C and that the anti-oxidant is selected from phenolic antioxidants thereby excluding amine antioxidants.

Claim 7 was amended similar to claim 2.

Claim 8 was cancelled.

The dependency of claim 9 was changed to claim 7.

Clean copies of the amended claims are enclosed.

REMARKS REGARDING REJECTIONS

The Examiner rejected claims 1 to 10 under 35 U.S.C. 102(e) as anticipated by Inoue. Applicants respectfully submit that the claims as amended obviate that rejection.

Both claims 1 and 6 require a lube oil that has a viscosity of 9 to 20 cSt at 100°C whereas the viscosity of Inoue's base oil is 2 to 8 cSt at 100°C. Thus the reference fails to anticipate applicants' gas engine oil.

Additionally, it is worth noting that Inoue teaches keeping the finished motor vehicle oil at a viscosity in the range of 5.6 to 12.5 cSt at 100°C whereas the oils of applicants' gas engine oil examples have a viscosity greater than 13 cSt at 100°C. Inoue also teaches that the base oil must have a very specific aromatic content without which good performance in a motor vehicle cannot be obtained. In contrast applicants have discovered that the performance of gas engine oils having a base oil viscosity of 9 to 20 cSt at 100°C is enhanced by the

combination of a phenolic antioxidant and a low level of VI improver. No such suggestion is made by Inoue.

The Examiner also rejected claims 1-11 under 35 U.S.C. 103(a) as unpatentable over Vienna. Applicants respectfully request the Examiner to reconsider and withdraw that rejection.

Vienna is concerned with hydraulic and transmission fluids whereas applicants' invention is directed to gas engine oils. The difference is significant. Indeed Vienna clearly points out (at column 1, liens 53 to 64) what is well known in the art that fluids suitable in one application may not be suitable in a different application and that additives effective in one application may not be effective in another. Such is so in the instant situation. Vienna, for example, uses a chlorinated fatty acid friction modifier in his fluid. Such a material could not be used in a gas engine oil because it would be too thermally unstable for the high temperature to which gas engine oils are subjected. Vienna teaches using tricreysl phosphates which would not be used in gas engine oils because of the adverse effect use of such a material would have on the engine exhaust catalyst system. Vienna's final composition has a minimum viscosity of 47 SSU (9 cSt) at 210°F whereas applicants' gas engine oil examples have a minor viscosity of about 13 cSt at 100°C. Vienna's final composition has a maximum viscosity of 12,000 SSU at 0°F whereas the viscosity of applicants' oil would be too thick to even measure at 0°F.

Clearly Vienna does not disclose a long life gas engine oil or method for enhancing gas engine oils.

In view of the foregoing comments and amendments applicants respectfully request the Examiner to pass the case to issue.

Respectfully submitted,

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